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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,097	11/27/2001	Nick (Nicholas Sheppard) Bromer		9382

7590 11/16/2005  
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EXAMINER

KLEBE, GERALD B

ART UNIT PAPER NUMBER

3618

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/995,097	Applicant(s) BROMER, NICK (NICHOLAS SHEPPARD)	
	Examiner Gerald B. Klebe	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2005 and 13 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5,6,9,11-15 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,9,11-15,17-24, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 6 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*G B Klebe*  
10 November 2005

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution Re-opened***

1. As a result of Board of Patent Appeals and Interferences decision of 09/19/2005 regarding the instant application, prosecution is hereby re-opened.

### ***Amendments***

2. Applicant's Amendment After Final Rejection and Board Action filed 10/03/2005 and Second Amendment After Final Rejection and Board Action filed 10/13/2005 have been entered. Claims 5-6, 9, 11-15, and 17-27 are pending in the application; claims 1-4, 7-8, 10, and 16 being cancelled and new claims 18-19 being added by the amendment filed 10/03/2005 and new claims 20-27 being added by the amendment filed 10/13/2005.

An action on the merits of the pending claims 5-6, 9, 11-15 and 17-27 follows; claims 5, 13, and 17 being independent.

### ***Claim(s) Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 13-15, 20-21 and 23-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 13 in lines 8-9 recites the limitation "wherein the lifter is positioned above the toe forward of metatarsals of the foot of the user". The phrase "forward of metatarsals of the foot of the user is a positive recitation of a part of a human being and is not patentable matter under 35 USC § 101.

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Claim 15 in lines 2-3 recites the limitation “a joint between a metatarsal and phalanx of the toe”. The phrase “ a joint between a metatarsal and phalanx of the toe” [of the user] (examiner’s addition provided in explanation) is a positive recitation claiming a part of a human being and is not patentable matter under 35 USC § 101.

Claims 20 and 21 each in lines 1-2 of the claim recite the limitation “a joint between a metatarsal and a phalanx of the toe” [of the user] (examiner’s addition provided for explanation). The phrase “a joint between a metatarsal and a phalanx of the toe” is a positive recitation claiming a part of a human being and is not patentable matter under 35 USC § 101.

A claim directed-to or including within its scope a human being or a part thereof will not be considered to be patentable subject matter under 35 USC § 101. Refer Notice of the Commissioner Quigg, 1077 OG 24 (April 21, 1987).

***Claims Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13-15, 20-21 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13, in lines 8-9 recites the limitation “wherein the lifter is positioned above the toe forward of metatarsals of the foot of the user”; claims 15, 20 and 21 each recites the limitation “wherein the lifter is pivoted about a pivot axis adjacent to a joint between a metatarsal and a phalanx of the toe”.

These recitations are unclear and indefinite since they recite locations of the structure in terms of measures that vary and therefore render the scope of the claim to be unascertainable. Since the location of the length of metatarsals cannot be expected to be the same from foot to foot of the user it is not clear whether what is being claimed as “above the toe forward of the metatarsals” is to mean that the structure is to be sized and assembled for each foot of each individual or whether it is intended that approximate distances be used to accommodate a variety of individuals or whether some other structural rendering is to be inferred. Similarly, the location of a pivot axis adjacent a joint between a metatarsal and a phalanx of the toe of a user is an indefinite definition of the location of the pivot axis of the inventive concept as here claimed because of the variability of the lengths of these structures of the human being, from person to person and between right and left feet of a single person and thus are unsuitable in clearly and definitely defining and establishing critical locations of these structural elements of the skate brake of the inventive concept.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 5, 12, 18, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlsmith (US 5232231).

Carlsmith discloses a skate braking mechanism (refer Figures 3-11 and associated text) comprising: (**re: claim 5**) a brake (combination of elements 24, 35, 32 and shoe 30 and drum

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41); a lifter (taken as the toe portion of 62) connected to the brake and pressable upward by the toe of the user to actuate the brake; wherein the brake comprises a brake shoe (30) coupled to the lifter, and wherein the brake shoe bears on at least one wheel (by virtue of the brake drum (41) being connected to the wheel (42); refer col 7, lines 46-55) of the skate when actuated; and, **(re: claim 12)** wherein the braking mechanism further comprises a return spring (22) counteracting and upward pressing motion of the toe (refer col 10, lines 2-6); and **(re: claim 18)** the lifter (62) is pivoted to be moved upward by the toe (refer col 9, lines 40-42); and **(re: claim 22)** wherein the brake shoe (30) is coupled to the lifter (62) via a linkage (see Figs 4 and 11, and refer col 9, lines 35-61 and col 10, lines 51-54).

9. Claims 13-15 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlsmith (US 5232231).

Carlsmith discloses a skate braking mechanism (refer Figures 3-11 and associated text) comprising: a skate braking mechanism comprising: **(re: claim 13)** a brake (combination of elements 24, 35, 32, 30 and 41); a lifter (taken as the toe portion of 62) connected to the brake and pressable upward by the toe of the user (refer col 9, lines 35-42 and col 10, lines 2-6); and wherein the lifter (taken as the toe portion of 62) is positioned above the toe of the user (inherently, as shown); and, **(re: claim 14)** wherein the lifter is pivoted to be moved upward by the toe (refer col 9, lines 40-42 and col 10, lines 2-6); and **(re: claim 15)** wherein the lifter is pivoted about a pivot axis (col 9, lines 35-40 and see Fig 11) adjacent the toe; and **(re: claim 24)** wherein the brake shoe (30) is coupled to the lifter (62) via a linkage (see Figs 4 and 11, and refer col 9, lines 35-61 and col 10, lines 51-54).

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10. Claims 17, 19 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoskin (US 5183275).

Hoskin discloses a skate braking mechanism for a user having a toe and standing on a skate comprising: (**re: claim 17**) a brake (Fig 1, item 10; and refer to the associated text); and a lifter (20f) connected to the brake and pressable upward by the toe of the user (refer col 6, lines 50-56); wherein the brake comprises a brake shoe (taken as the surface 72r of wheel 82r; refer col5, lines 51-54) that is pivoted to rotate about an axle (106a) of a first wheel (82r), so as to bear against a second wheel (23w); and wherein (**re: claim 19**) the lifter is pivoted to be moved upward by the toe (refer col 6, lines 50-53); and (**re: claim 26**) wherein the brake shoe (72r) is coupled to the lifter (20f) via a linkage (combination 94s and 96s).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 9, 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsmith (US 5232231).

As discussed above, Carlsmith discloses all of the features of claim 5 from which claims 9, 11 and 27 depend. Carlsmith further discloses the use of urethane elastomer for the wheels but is silent regarding the material of the brake shoe.

However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have used (**re: claims 9, 11 and 27**) a fiber-reinforced urethane

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elastomeric material for the brake shoe since fiber-reinforced urethane elastomers are old and well-known materials in the in-line skate manufacturing art and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Claims NOT rejected over the Prior Art***

13. Claims 20, 21 and 23 are not rejected as being anticipated by or unpatentable over the prior art of record, however these claims are nonetheless NOT in condition for allowance in view of the rejections of these claims under 35 U.S.C. § 101, as set forth above.

***Allowable Subject Matter***

14. Claims 6 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Prior Art made of Record***

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Bellehumeur (-015); of Johnson; of Perner; of Chou; of Pennestri; of Shifrin; of Stoughton et al.; of Gatel et al.; of Gignoux et al.; of Strothmann et al.; and of Colla each show features in common with some of the other structures of the inventive concept disclosed in the instant application.

***Conclusion***

16. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 571-272-6695; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 571-272-6914.

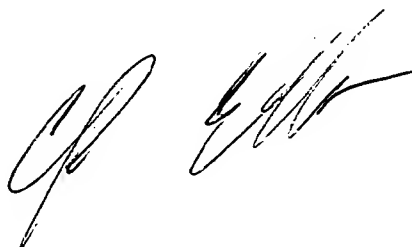


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Official correspondence should be sent to the following TC 3600 Official number as follows: 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*gbklebe*  
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